

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte Mark M. Sterner,  
Mark H. Sterner and Ronald S. O. Zane

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Appeal No. 95-2456  
Application No. 07/059,895<sup>1</sup>

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner=s decision rejecting claim 47, the only claim remaining in the application.

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<sup>1</sup> Application for patent filed May 7, 1993. According to appellants, the application is a continuation of Application 07/915,430, filed July 17, 1992, now abandoned.

Claim 47, which is illustrative of the subject matter on appeal, reads as follows:

A process for preparing a leguminous snack food comprising the steps of:  
preconditioning legumes by soaking the legumes in water at a temperature of approximately 212 degrees fahrenheit such that the legumes are hydrated to a moisture content between 52% and 55%, by weight;  
next, cooking the legumes, the method for cooking the legumes chosen from the list consisting of:  
submerging the legumes in water and boiling the water at a pressure higher than ambient pressure;  
disposing the legumes in a rotating vessel and heating the legumes with steam under pressure;  
next, cooling the legumes by immersing the legumes in water having a temperature of less than approximately 90 degrees fahrenheit;  
next, dehydrating the legumes at approximately ambient pressure by blowing moisture laden air thereover at a velocity of between approximately 500 and approximately 1,500 fpm and gradually lowering the temperature and relative humidity of the air blown thereover from an initial temprature of approximately 235 degrees fahrenheit and an initial relative humidity of approximately 50% to a final temperature of approximately 160 degrees fahrenheit and a final humidity of approximately 10% until the moisture content of the legumes is in the range of approximately 6% to 8%, by weight, so as to mitigate the problem of incurring a Maillard reaction;  
next, enrobing the legumes by binding the legumes with flavoring; and  
wherein the legumes are chosen from the list consisting of:  
pinto beans;

pink beans;  
red beans;  
black beans;  
navy beans;  
black eye beans;  
kidney beans;  
garbanzo beans;  
lentils; and  
peas.

The references relied on by the examiner are:

Schaffner	2,402,675	Jun. 25, 1946
Thompson et al. (Thompson)	3,291,615	Dec. 13, 1966
Mader	3,738,848	Jun. 12, 1973
Sterner et al. (Sterner)	4,871,567	Oct. 3, 1989

Marion Julia Drown (Drown), ASoybeans and Soybean Products as Food@, Miscellaneous Publication No. 534, U.S. Department of Agriculture, Issued December 1943.

The issue presented for review is whether the examiner erred in rejecting claim 47 under 35 U.S.C. '103 over Schaffner taken together with Thompson, Mader, Drown and Sterner.

On consideration of the record, including the final rejection (paper no. 8), brief (paper no. 10), examiner=s answer (paper no. 11) and reply brief (paper no. 12), we reverse the examiner=s rejection.

#### Discussion

We conclude that the examiner has not established a prima facie case of obviousness for the reasons stated in appellants' Reply Brief. We agree with the Reply Brief that the only way to arrive at the claimed method is to impermissibly use appellants' specification as a blueprint.

As this court has stated, >virtually all [inventions] are combinations of old elements.= Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983), *cert denied*, 464 U.S. 1043 (1984); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (>Most, if not all, inventions are

combinations and mostly of old elements.=). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be >an illogical and inappropriate process by which to determine patentability.= Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled

artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-8

(Fed. Cir. 1998).

The examiner's answer sets out eight claim limitations not provided for in Schaffner. In most instances an additional reference is relied upon to overcome a particular missing limitation and to evidence conventionality; although in some cases, the missing limitations are described as being Awell within the purview of a skilled artisan@ (examiner's answer, p. 7) or as Aan art recognized parameter@ (examiner's answer, sentence bridging pp. 7-8). However, we are provided no reason why one of ordinary skill

would want to make all these changes to Schaffner's

soybean

drying process to arrive at appellants= leguminous snack-making process, which does not involve soybeans.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint

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for piecing together the prior art to defeat  
patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)

Since A[o]bviousness can not be established by hindsight  
combination to produce the claimed invention,@ In re  
Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.  
Cir. 1998), a prima facie case of obviousness has not  
been established and, accordingly, we reverse the  
rejection.

REVERSED

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
WILLIAM F. SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
HUBERT C. LORIN	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/059,895

APJ Lorin

APJ Winters

APJ Smith

DECISION: REVERSED

Prepared By:

**DRAFT TYPED:** 27 Jul 0

**FINAL TYPED:**